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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,579	08/20/2003	Connie Sanchez	05432/100M919-US1	5200
7278	7590	03/29/2007	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			CHONG, YONG SOO	
			ART UNIT	PAPER NUMBER
			1617	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/644,579	SANCHEZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yong S. Chong	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 March 2007.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 20-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/6/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### *Status of the Application*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/6/2007 has been entered.

Claim(s) 1-19 have been cancelled. Claim(s) 20-40 are pending and are examined herein.

Applicant's arguments have been fully considered but found not persuasive. The rejection(s) of the last Office Action are maintained for reasons of record and repeated below for Applicant's convenience.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-46 of copending Application No. 10/468,685; claims 20-34 of copending Application No. 10/644,587, and claims 20, 22-37 of copending Application No. 10/644,588 in view of applicant's own admission.

Applications 10/468,685 and 10/644,587 disclose a method of treating depression by administering escitalopram, while application 10/644,587 discloses a method of treating depression in a patient who is being administered a selective serotonin reuptake inhibitor other than escitalopram. These applications do not disclose a patient population who has failed to respond to initial treatment with a selective serotonin reuptake inhibitor other than escitalopram.

In applicant's own admission, the specification discloses that clinical studies on depression and anxiety disorders indicate that non-response or resistance to SSRIs, where at least 40-60% reduction in symptoms has not been achieved during the first 6 weeks of treatment (pg. 1, paragraph 3).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to administer escitalopram to a patient who failed to respond to the initial treatment with a selective serotonin reuptake inhibitor other than escitalopram.

A person of ordinary skill in the art would have been motivated to administer escitalopram because of the reasonable expectancy of successfully optimizing a treatment for depression using another selective serotonin reuptake inhibitor.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

Applicant's request that these provisional rejections be held in abeyance is acknowledged. The double patenting rejections are maintained for reasons of record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in Graham vs John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 20-40 are rejected under 35 U.S.C. 103(a) as being obvious over Boegesoe et al. (US Patent 4,943,590) in view of applicant's own admission.

The instant claims are directed to a method of treating depression in a patient, who failed to respond to initial treatment with a selective serotonin reuptake inhibitor other than escitalopram, by administering a pharmaceutically effective amount of escitalopram.

Boegesoe et al. discloses the method of treating depression in a patient with the (+) enantiomeric form of citalopram, otherwise referred to as escitalopram (col. 1, lines 9-26), which is also disclosed to be an inhibitor of serotonin uptake. Acceptable

pharmaceutical salts of escitalopram include oxalate (col. 1, lines 29-42). The daily dosage of escitalopram is disclosed to be from 5 to 50 mg (col. 8, lines 55-60).

However, Boegesoe et al. fail to disclose specifically the patient population that consists of those who failed to respond to the initial treatment with a selective serotonin reuptake inhibitor other than escitalopram.

In applicant's own admission, the specification discloses that clinical studies on depression and anxiety disorders indicate that non-response or resistance to SSRIs, where at least 40-60% reduction in symptoms has not been achieved during the first 6 weeks of treatment (pg. 1, paragraph 3).

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to administer escitalopram to a patient who failed to respond to the initial treatment with a selective serotonin reuptake inhibitor other than escitalopram.

A person of ordinary skill in the art would have been motivated to administer escitalopram because of the reasonable expectancy of successfully optimizing a treatment for depression using another selective serotonin reuptake inhibitor, especially since Boegesoe et al. disclose escitalopram as being the more effective enantiomer at inhibiting serotonin uptake.

Examiner respectfully points out that the limitation directed to an amount "to obtain an effect in a patient after one week," has been inherently met as a result of meeting the limitations with respect to drug, dosage, and patient population.

***Response to Arguments***

Applicant argues that there is no motivation to administer escitalopram to treat depression in patients who have failed to respond to initial treatments with a different SSRI. Specifically, one of ordinary skill in the art would have had no reasonable expectation that a patient would be responsive to another member of the same drug class, especially if they have already demonstrated resistance to the treatment with an SSRI. Moreover, Applicant argues that there are many other treatment options available for patients with depression than to single out escitalopram from other SSRIs.

This is not persuasive because, at the outset, Applicant is reminded that if a patient did not respond to a particular SSRI, it would have been obvious to one of ordinary skill in the art to administer another SSRI with the same reasonable expectation of successfully treating depression. This is corroborated by the fact that, although the function remains the same, there is no one core structure associated with SSRI, as there are many structurally different classes of drugs that can be called SSRIs. All of these drugs have varying degrees of bioavailability as a result of their structures. Furthermore, in applicant's own admission, the specification discloses that clinical studies on depression and anxiety disorders indicate that non-response or resistance to SSRIs, where at least 40-60% reduction in symptoms has not been achieved during the first 6 weeks of treatment (pg. 1, paragraph 3). Therefore, it would have been obvious to administer another SSRI, such as escitalopram, with a reasonable expectation of success in treating depression.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

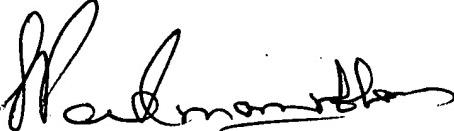
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER